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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,200	12/27/2001	Robert E. Novak	4000.2.48	7751
32641	7590	07/14/2005	EXAMINER	
DIGEO, INC C/O STOEL RIVES LLP 201 SOUTH MAIN STREET, SUITE 1100 ONE UTAH CENTER SALT LAKE CITY, UT 84111			LUU, SY D	
			ART UNIT	PAPER NUMBER
			2174	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/034,200	NOVAK ET AL.	
	Examiner	Art Unit	
	Sy D. Luu	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on the communications filed 4/20 & 4/28/05.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9,11-33,35-47 and 49-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-9,11-33 and 35-47 is/are allowed.
- 6) Claim(s) 49-57 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 December 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment filed April 20, 2005.
2. Claims 1-57 are pending in this application. Claims 1, 25, 49 and 57 are independent claims. In the instant Amendment, claims 1, 17, 25 and 41 were amended, claims 10, 34 and 48 were cancelled, and claims 49-57 were added. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 49-54 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Sull et al (“Sull”, US 2002/0069218 A1).

As per claim 49, Sull teaches a method for distributing personalized editions of media programs (abstract; paragraph 365), the method comprising:

accessing a media program at an editing device (fig. 2);

receiving a designation of at least one excerpt of the media program for inclusion in a personalized edition of the media program, and generating at least one bookmark defining each designated excerpt of the media program, wherein the bookmark includes supplemental information to be displayed in conjunction with the designated excerpt (paragraphs 32, 50, 54, 70, 205, and 359);

transmitting the at least one bookmark to a playback device having access to the media program, wherein the at least one bookmark is usable by the playback device to present the personalized edition of the media program including only the at least one designated excerpt with the supplemental information (paragraphs 52, 63, 71, 78).

As per claims 50-54, Sull teaches the supplemental information to comprise text, or a hyperlink to content, or an image, or audio/video content to be displayed in conjunction with the designated excerpt (figs. 61-62; paragraphs 359, 52 and 9).

As per claim 56, Sull discloses the supplemental information to comprise a commentary by a user of the editing device that created the personalized edition of the media program (paragraph 32; *annotations*).

Claim Rejections - 35 USC § 103

6. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sull et al (“Sull”, US 2002/0069218 A1) in view of Brown et al. (“Brown”, US 6,868,225 B1).

As per claims 54-55, Sull does not expressly disclose the supplemental information to comprise audio content as well as the video content to be presented in a PIP window with the designated excerpt. However, presenting video content in a PIP window is known in the art.

For instance, Brown teaches a multimedia program bookmarking system, wherein a PIP window is employed to view another media program concurrently with a program being viewed (col. 11, lines 63-67). It would have been obvious to an artisan at the time of the invention to combine this feature with Sull's teaching in order to further enhance a user's visual experience in providing means to facilitate switching and viewing of desired program media.

7. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sull et al ("Sull", US 2002/0069218 A1) in view of Applicant's Admitted Prior Art ("AAPA", Specification).

As per claim 57, all claim limitations have been addressed in previous paragraphs, and would be rejected under similar rationale. Sull further indicates the media programs to be TV programs (paragraph 57). However, Sull does not explicitly indicate the editions of the TV programs to be free of commercial advertisements. AAPA discloses personalized editions of media programs that is free of commercials (paragraph 5 of in the BACKGROUND section). Therefore, it would have been obvious to an artisan at the time of the invention to combine such a feature with Sull's teaching in order to provide media editions that contain only highlights or desired program content.

Allowable Subject Matter

8. Claims 1-9, 11-33, and 35-47 are allowed.
9. The prior art made of record fails to anticipate or make obvious the claimed invention. Specifically, the prior art fails to teach, in combination with the remaining elements: the PIO

comprising one or more user-selectable actions performable in connection with the media program, as recited in claims 1 and 25.

The closest prior art, Sull et al. (US 2002/0069218 A1) discloses a substantially similar method and system for distributing personalized editions of media programs using bookmarks.. However, Sull et al. fail to anticipate or render the above cited limitations obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is (571) 272-4064. The examiner can normally be reached on Monday - Friday from 7:300 am to 4:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (571) 272-4063.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SY D. LUU
PRIMARY EXAMINER
ART UNIT 2174